

REMARKS

Claims 2-21 are pending in the present application, of which claim 12 has been amended as explained below. Claims 3, 4, and 6-10 have also been amended in order to fix incorrect dependencies. Applicant respectfully requests favorable reconsideration and allowance of the present application.

I. 35 U.S.C. § 101

The Office Action rejected claims 12-21 under 35 U.S.C. § 101 because the claims fail to fall within the statutory categories of § 101. For the reasons that follow, Applicant respectfully traverses this basis for rejection.

Claim 12 is directed to a method for facilitating electronic collaboration and calls for, among other elements, receiving preliminary profile data at a community creation database. A database is a particular apparatus used to store data. Claim 12 now calls for enabling creation of at least one profile at a digital storage center for a live user of the plurality of live users in the one of the plurality of communities. A digital storage center is also a particular device, machine, or apparatus used to store data. As amended, claim 12 also calls for searching at least the digital storage center via a search engine for data related to another of the plurality of lives users.

Accordingly, claim 12 is tied to another statutory class and, therefore, patentable under 35 U.S.C. § 101 for at least this reason. Claims 13-21 depend either directly or indirectly from claim 12 and thus include the elements of claim 12. Accordingly, claims 13-21 are also tied to another statutory class and patentable for at least the same reason. Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

II. 35 U.S.C. § 103(a)

a. Claim 2

The Office Action rejected claims 2-9 and 12-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2003/0050986 (hereinafter "*Matthews*") in view of U.S. Patent No. 6,249,282 (hereinafter "*Sutcliffe*") in further view of U.S. Published Patent Application 2004/0064515 (hereinafter "*Hockey*"). For at least the reasons set forth below, Applicant respectfully traverses this basis of rejection.

Claim 2 is directed to an apparatus for electronic collaboration in an environment including a plurality of communities, each of the plurality of communities having a plurality of live users and at least one community administrator. Among other elements, the apparatus comprises a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria established by a monitor, wherein the flagging filter is configured to flag communications for review prior to release to their intended recipient.

While *Matthews* states that a group administrator may also have the authority to monitor interaction on message boards and/or to remove inappropriate content, *Matthews* does not disclose, suggest, or teach a system or method wherein a flagging filter flags communications between users based on a textual portion of the communications according to predetermined criteria established by a monitor prior to release to their intended recipient.

The Office Action states that *Hockey* fills the deficiencies of *Matthews* by disclosing a system wherein messages may be flagged according to certain thresholds and attributes. *Hockey* discloses a system that changes a message's attributes so that it may not be

delivered or opened, and/or may be placed in a quarantine zone for review by a system administrator. This is accomplished, however, based on a review of a numerical digest associated with each communication; not on the textual portion of the communication.

The claim limitation set forth above is not obvious in light of *Matthews* in view of *Hockey* also because one of ordinary skill in the art could not and would not combine the elements of *Matthews* and *Hockey* in order to perform the function of the claimed limitation. As stated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007):

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovative the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Id. at 419.

Hockey discloses a method for monitoring mail messages particularly for virus attacks and unsolicited commercial email ("spam"). See *Hockey*, abstract. The system described by *Hockey* attempts to accomplish this purpose by generating a numerical representation (a "digest") for the combined subject line and message content (*Hockey*, ¶ 96) and comparing the resulting digest with existing digests stored in memory (*Hockey*, ¶ 102). The *Hockey* system creates and compares the mathematical digest from an electronic mail message ("email") with other stored digests because analyzing the textual content of the email would fail to prevent dissemination of certain viruses and spam – which is the

specific purpose of the *Hockey* system. Viruses, such as email worms, and spam generally do not contain content that would be deemed inappropriate by a monitor or filter. It is important to note (as it is expressly noted in *Hockey*) that email worms generally contain malicious code (which would be undetectable to a monitor analyzing textual content), but otherwise “comprise a suitably benign message as further means of deception to the recipients.” *Hockey*, ¶ 6 (emphasis added). Thus, the ability to monitor and/or remove inappropriate content based on textual content as described in *Matthews* would have no effect on identifying the emails that the *Hockey* system attempts to prevent. That is, *Hockey* states that monitoring the textual content of certain emails that contain viruses or spam would be useless with respect to the purpose of the *Hockey* system. See *Hockey*, ¶¶ 5-12. In fact, *Hockey* both distinguishes and teaches away from systems wherein communications are filtered based on character strings that the recipient desires not to receive. *Hockey*, ¶ 11. That is, *Hockey* specifically distinguishes systems, such as the one described in *Matthews* and the claimed invention, on the basis that monitoring textual content is ineffective to protect against spam and virus attacks, such as email worms.

Likewise, attempting to modify the system disclosed in *Matthews* with the system set forth in *Hockey* would cause the *Matthews* system to fail for its intended purpose. That is, reviewing messages based on a numerical digest would have no effect on attempting to prevent delivery of communications containing inappropriate content. This is a classic example of teaching away – when the systems of both references would fail for their intended purposes if combined to render the claimed invention. Accordingly, one of ordinary skill in the art would not (and could not) combine elements of the systems disclosed in *Hockey* and *Matthews* to provide the claimed invention.

Additionally, independent claim 2 requires the predetermined criteria used to analyze the relevant communications be established by a monitor. This claim limitation requires the criteria be (1) predetermined and (2) established by a monitor. As noted above and in the Office Action, *Matthews* fails to expressly disclose a second filter that monitors communications between a plurality of live users. *Matthews*, therefore, does not disclose, teach, or suggest filtering based on predetermined criteria established by a monitor.

As explained above, *Hockey* generates a numerical digest for a communication and compares it to the numerical digest of communications that are known to be spam, viruses, or worms. These numerical digests are created based on the combined subject line and message content so that each communication is associated with a specific numerical digest. Nothing in *Hockey* discloses, teaches, or suggests analyzing the communications based on criteria established by a monitor.

Moreover, the Office Action fails to clearly set forth the required rationale as to why the claimed invention would have been obvious to one of ordinary skill in the art. *KSR*, 550 U.S. at 418. For instance, the Office Action lacks any explanation or evidence why or how one of ordinary skill in the art would have or could have combined the subject matter of *Matthews*, *Sutcliffe*, and *Hockey*. Furthermore, because the resulting combination of *Matthews*, *Sutcliffe*, and *Hockey* lacks at least one element of the claimed subject matter, as explained above, there is no reason or rationale why or how one of ordinary skill in the art would have or could have combined the prior art to render the claimed subject matter. Also, as set forth above, the combination of *Matthews*, *Sutcliffe*, and *Hockey* would have failed for both the intended purpose set forth in *Matthews* and the one set forth in *Hockey*.

Thus, no reason why one of ordinary skill in the art would combine the references can be established for this reason as well.

In sum, combining the ability to monitor and/or remove inappropriate content described in *Matthews* with the quarantining of messages based on comparison of a numerical digest of the message with other stored numerical digests described in *Hockey* would: (1) render the filtering system disclosed by *Hockey* inoperable and useless for its intended purpose, and (2) would fail to flag any messages based on inappropriate content for the purpose described in *Matthews*. A system that combines elements of the *Matthews* system and the *Hockey* system described above would result in a system that would fail for both the purpose of the *Matthews* system and the purpose of the *Hockey* system. Thus, there is no "reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does." See *KSR*, 505 U.S. at 419. Importantly, *Hockey* distinguishes and teaches away from monitoring and/or removing messages based on content, which is the portion of *Matthews* the Office Action seeks to combine with *Hockey*.

Since *Hockey* teaches away from *Matthews*, there is nothing to prompt a person of ordinary skill to combine the elements found in *Hockey* and *Matthews*. Importantly, combining the relevant elements of *Hockey* and *Matthews* would defeat the purposes of both *Hockey* and *Matthews* and render the combined system inoperable. Thus, the present limitation is not obvious in light of *Matthews* in view of *Hockey*. Accordingly, the combination of *Hockey* and *Matthews* is unable to rectify the deficiencies of *Matthews* alone with respect to the current limitation.

For at least these reasons, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

b. Claims 3-9

Claims 3-9 depend either directly or indirectly from independent claim 2 and recite additional limitations. Because the combination of *Matthews*, *Sutcliffe*, and *Hockey* fails to disclose every element of independent claim 2, it also fails to disclose every element of dependent claims 3-9. Additionally, the Office Action fails to set forth the required rationale why and how it would have been obvious to one of ordinary skill in the art to combine the references to provide the claimed invention. These claims are therefore not anticipated by *Matthews* in view of *Sutcliffe* in further view of *Hockey* and are thus patentable in their respective combinations. Additionally, *Matthews*, *Sutcliffe*, and *Hockey* fail to disclose the additional limitations set forth in these dependent claims and/or their respective combinations. For at least these reasons, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

c. Claim 12

Claim 12 is directed to a method for facilitating electronic collaboration in an environment including a plurality of communities, each of the plurality of communities having a plurality of live users and at least one community administrator. Among other elements, the method comprises monitoring communications between the plurality of live users at a second filter. The second filter includes at least a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria established by

a monitor, wherein the flagging filter is configured to flag communications for review prior to release to their intended recipient. Additionally, claim 12 requires the predetermined criteria used to analyze the relevant communications be established by a monitor. This claim limitation requires the criteria be (1) predetermined and (2) established by a monitor.

As set forth above, *Matthews* does not disclose, suggest, or teach a system or method wherein a flagging filter flags communications between users based on a textual portion of the communications according to predetermined criteria established by a monitor prior to release to their intended recipient. *Hockey* fails to remedy the deficiencies of *Matthews* with respect to the claimed invention. Additionally, one of ordinary skill in the art could not and would not combine the elements of *Matthews* and *Hockey* in order to perform the function of the claimed limitation. Combining *Matthews* and *Hockey* would cause the resulting combination to fail for both the intended purposes set forth in *Matthews* and *Hockey*.

Moreover, the Office Action fails to clearly set forth the required rationale as to why the claimed invention would have been obvious to one of ordinary skill in the art. *KSR*, 550 U.S. at 418. For instance, the Office Action lacks any explanation or evidence as to why or how one of ordinary skill in the art would have or could have combined the subject matter of *Matthews*, *Sutcliffe*, and *Hockey*.

For at least these reasons, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

d. Claims 13-19

Claims 13-19 depend either directly or indirectly from independent claim 12 and recite additional limitations. Because the combination of *Matthews*, *Sutcliffe*, and *Hockey* fails to disclose every element of independent claim 12, it also fails to disclose every element of dependent claims 13-19. Additionally, the Office Action fails to set forth the required rationale as to why and how it would have been obvious to one of ordinary skill in the art to combine the references to provide the claimed invention. These claims are therefore not anticipated by *Matthews* in view of *Sutcliffe* in further view of *Hockey* and are thus patentable in their respective combinations. Additionally, *Matthews*, *Sutcliffe*, and *Hockey* fail to disclose the additional limitations set forth in these dependent claims and/or their respective combinations. For at least these reasons, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

e. Claims 10 & 20

The Office Action rejected claims 10 and 20 in view of *Matthews*, *Sutcliffe*, and *Hockey*, in further view of an Official Notice that it would have been widely known to one of ordinary skill in the art that profiles be created in a plurality of languages such that communities may span a plurality of international backgrounds. For at least the reasons set forth below, Applicant respectfully traverses this basis of rejection.

Rejections that take “official notice” of facts not in the record or rely on common knowledge in making a rejection should be judiciously applied and “should be rare.” MANUAL OF PATENT EXAMINING & PROCEDURE (hereinafter “MPEP”) § 2144.03. “[T]he notice of facts beyond the record which may be taken by the examiner must be ‘capable of such

instant and unquestionable demonstration as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (citations omitted). It is inappropriate for an Office Action to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. MPEP § 2144.03.

Nonetheless, the basis for the Official Notice must be set forth explicitly. *Id.* “The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support [the] conclusion of common knowledge.” *Id.* (citations omitted). Applicant is unable to adequately traverse the present rejection due to the lack of any basis for which the Office Action regarded the subject matter as subject to the Official Notice. Applicant is unaware, and the record is devoid, of any evidence that the subject matter subject to the Official Notice was common knowledge or well-known in the art when the invention was made. Accordingly, Applicant respectfully requests documentary evidence supporting the Official Notice should the rejection be maintained. “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” *Id.* (citing 37 C.F.R. § 1.104(d)(2)).

Accordingly, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

f. Claims 11 & 21

The Office Action rejected claims 11 and 21 in view of *Matthews*, *Sutcliffe*, and *Hockey*, in further view of an Official Notice that it would have been widely known to one of

ordinary skill in the art to associate languages with a profile and implement a search according to the language characteristic of a plurality of live users.

As noted above, such rejections should be judiciously applied and “should be rare.” MPEP § 2144.03. Applicant is unaware, and the record is devoid, of any evidence that the subject matter subject to the Official Notice was common knowledge or well-known in the art when the invention was made. Accordingly, Applicant respectfully requests documentary evidence supporting the Official Notice should the rejection be maintained. Accordingly, Applicant respectfully requests withdrawal of this basis for rejection, favorable reconsideration, and allowance of the present application.

III. Conclusion

The claimed invention set forth in claims 12-21 are tied to another statutory class and are therefore directed to patentable subject matter pursuant to 35 U.S.C. § 101. Additionally, and for the reasons stated above, claims 2 and 12 are not obvious in view of *Matthews*, *Sutcliffe*, and *Hockey*. The remaining claims depend from these independent claims, recite further limitations, and are therefore allowable in their respective combinations. Furthermore, the Office Action took official notice of certain facts with respect to claims 10, 11, 20, and 21. Applicant is unaware, and the record is devoid, of any evidence supporting these Official Notices. Applicant respectfully requests documentary evidence of these facts should the rejections based on the Official Notices be maintained.

Favorable action by the Examiner and withdrawal of the cited rejections is respectfully requested. The Examiner is invited to call the undersigned in an effort to discuss and resolve any remaining issues.

Respectfully submitted,

NELSON MULLINS RILEY & SCARBOROUGH, LLP.

/s/ Jeremy C. Whitley/
Jeremy C. Whitley
Registration No. 58,775
ip@nelsonmullins.com
100 North Tryon Street | 42nd Floor
Charlotte, North Carolina 28202
Office: (803) 255-9764 | Fax: (803) 255-9831